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10/049,162	02/08/2002	Nobuchika Hirashima	7388/72600	7831

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FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

LUONG, SHIAN TINH NHAN

ART UNIT PAPER NUMBER

3728

DATE MAILED: 01/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/049,162

Applicant(s)

Hirashima et al.

af

Examiner

Shian T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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Response to Amendment

1. The amendment filed on 12/15/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the tear off cutting lines being located positions which the adhesive layer exist in a direction perpendicular to the one side surface of they tape type support.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. 112, first paragraph, and 37 C.F.R.

1.71(a) and (b) as failing to provide an adequate written description of the invention, and failing to adequately teach how to make and/or use the invention. The phrase “the tear off cutting lines being located positions which the adhesive layer exist in a direction perpendicular to the one side surface of they tape type support” lacks sufficient support in the specification. The adhesive material is parallel to the side surface of the tape type support and not perpendicular thereto. Clarification is required and no new matter is permitted.

3. Claims 11-26 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth

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in the objection to the specification.

4. Claims 11-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, the term "the tape type patch" lacks proper antecedent basis. Also, in claims 1 and 20, the phrase "the tear off cutting lines being located positions which the adhesive layer exist in a direction perpendicular to the one side surface of they tape type support." The adhesive material is parallel to the side surface of the tape type support and not perpendicular thereto. The claim specifically requires the adhesive to be lamination on all over one side surface of the tape type support. In claim 15, the term "covering layer" lacks proper antecedent basis. Appropriate correction is required.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the tear off cutting lines being located positions which the adhesive layer exist in a direction perpendicular to the one side surface of they tape type support must be shown or the feature canceled from claims 11 and 20. No new matter should be entered.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 11-13, 19 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 in view of S61-108257 and Tomaiuolo (US 5,782,786). JP S57-111822, JP S55-134822 and JP S56-60730 all disclose of a roll-wound plaster with a medicinal part on the plaster. JP S57-111822 and/or JP S55-134822 and/or JP S56-60730 do not disclose the specific material and tear off cutting lines. S61-108257 discloses a tape-protecting case with left and right covers engaging a core and protecting the side surfaces of adhesive tape. The engaging element is the protrusion shown in Figures 2-3. It would have been obvious to form a roll by winding an adhesive strip around the outside of a core but within the cover to prevent soiling and deformation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the cover out of polyacrylonitrile resin and the core out of polyethylene terephthalate resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

Tomaiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would have been obvious in view of Tomaiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination.

Applicant argues that Tomaiuolo teaches providing tear lines at a position between the absorbent layer and not thereon. But Tomaiuolo is applied to show the use of tear lines while the base reference already display that the tape patch is a continuous strip of material. The tear lines

can be located anywhere on the tape patch as it is commonly known in the art for separating a portion of the tape patch therefrom.

8. Claim 18 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claim 11, further in view of Official Notice. The modified reference does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0mm and a slit spacing of 1.0-1.5mm and the breaking strength of 7.36-15.24kgf/48 mm width. by experimenting different size of cut and location. The slit width and spacing is to facilitate separation of a portion of the tape type support. To make the slit a certain width and to determine the spacing therebetween is an indication of how much effort a user has to assert in order to separate a portion of the tape type support. One of ordinary skill in the art would readily recognize different width and spacing as conventional knowledge to improve the tearing strength required of a user.

9. Claims 11-16, 19-24, 26 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted Prior Art on page 1 of the specification in view of Tomaiuolo (US 5,782,786). Admitted Prior Art discloses external patch rolls composed of a dispenser core and a strip-like patch wrapped around the outer perimeter side. The external patches are usually constructed with a support made of nonwoven fabric, an adhesive layer laminated on one side thereof and a covering attached to the adhesive layer in a releasable manner. Admitted Prior Art does not disclose two covers adjacent to the roll and the specific material. Tomiuolo teaches an adhesive bandage on a strip of material. The bandages are separated by perforations or slits. It would

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have been obvious in view of Tomiuolo to provide covers attached to the spool to surround the edges of the strip to prevent contamination. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the side covers out of ployacrylonitrile resin and the core and covering layer out of polyethylene terephthalate resin, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.

10. Claim 17-18, 25 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over the references applied above with respect to claims 11 and 20, further in view of Official Notice. The modified reference does not disclose the width and spacing of the perforation slits. But one of ordinary skill in the art would determine the proper width of the slit and the spacing between the slits through routine experiments. Hence, it would have been obvious to provide a width of 1.0-2.0mm, a slit spacing of 1.0-1.5mm and the breaking strength of 7.36-15.24kgf/48 mm width by experimenting different size of cut and location.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners, M.P.E.P. 203.08. The **Group clerical receptionist number is (703) 308-1148** or the **Tech Center 3700 Customer Service Center number is (703) 306-5648**.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers should be directed to Donna Monroe at (703) 308-2209.


For applicant's convenience, the formal FAX number is (703) 872-9306. This practice may be used for filing papers not requiring a fee. It may also be used for filing papers which require a fee by applicants who authorize charges to a PTO deposit account. Please identify Examiner Luong of Art Unit 3728 at the top of your cover sheet of any correspondence submitted.

Inquiries concerning the merits of the examination should be directed to Shian Luong whose telephone number is (703) 308-2039. The examiner can normally be reached on M-H from 7:00am to 4:00pm EST.

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January 27, 2004


Primary Examiner
Shian Luong
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